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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,733	09/24/2001	Gaute Munch	2388-797	7816
29540	7590	05/03/2004	EXAMINER	
PITNEY HARDIN LLP 685 THIRD AVENUE NEW YORK, NY 10017-4024			CAPRON, AARON J	
			ART UNIT	PAPER NUMBER
			3714	
DATE MAILED: 05/03/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/890,733

Applicant(s)

MUNCH ET AL.

Examiner

Aaron J. Capron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-16 and 18-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-16 and 18-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

This is a response to the Amendment received on February 19, 2004, in which claims 1, 5-6, 14 and 18 were amended, claims 27-34 were added, and claims 4 and 17 were cancelled. Claims 1-3, 5-16 and 18-34 are pending.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 19, 2004 has been entered.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title; if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-16 and 18-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haugerud et al. (U.S. Patent No. 4,712,184; hereafter "Haugerud") in view of Chainani et al. (U.S. Patent No. 5,724,074; hereafter "Chainani"). This holding is maintained from prior

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action for cited claims, as amended, which is incorporated herein. Response to Applicant assertions is provided below and incorporated herein.

Referring to claim 1, Haugerud discloses a microprocessor controlled toy building element comprising a microprocessor which can execute instructions in the form of a program stored in a memory (abstract); a display integrated in the toy building element (6:57-59), coupling means for coupling with building elements that can be moved by maneuvering means, the maneuvering means being controllable in response to the instructions (abstract), characterized in that the display is configured to direct patterns of movements and activated by a user for programming the microprocessor (abstract) and by signaling a pattern of movement followed by the toy building element, but does not disclose that the display incorporates icons to maneuver the toy building element. However, Chainani discloses a home computer in connection with a programmable toy that maneuvers the programmable toy by icons displayed on the personal computer (Figure 7) in order to allow children to program a toy microprocessor (1:57-64). The two references are analogous since both refer to controlling a programmable toy through the use of a personal computer. One would be motivated to combine the references in order to allow Haugerud's system to be more acceptable for a young child to program and maneuver the remote control device. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the maneuvering icons of Chainani into the device of Haugerud in order to be more acceptable for a young child to program and maneuver the remote control device.

Referring to claim 2, Haugerud and Chainani disclose the type of icons is configured to illustrate modifications of patterns of movements (Chainani: Figure 7).

Referring to claim 3, Haugerud and Chainani disclose that the toy comprises means for generating a first set of instructions comprising parameters upon activation of a first type of icons which instructions and/or parameters may be modified by activation of a second type of icons (Chainani: Figure 7- item 158).

Referring to claim 5, Haugerud and Chainani disclose that a first group of rules is conditioned by a first group of signals and that a second group of rules is conditioned by a second group of signals (Chainani: Figure 7- item 158- "Move L90, 3, @60; Lights On;").

Referring to claim 6, Haugerud and Chainani disclose instructions corresponding to one icon implement one rule by controlling the maneuvering means in response to signals from electrical and/or electronic units.

Referring to claim 7, Haugerud and Chainani disclose the microprocessor executes rules in the form of instructions which control units, the rules being conditioned by a plurality of signals (Chainani: moving forward and changing the direction of the wheels to turn, turning the lights on and beeping the horn), the prioritized order indicating which one of the several rules is to be allowed to control a unit (Chainani: Figure 7), the order being arranged accordingly to the signals by which they are conditioned (Chainani: Figure 7).

Referring to claim 8, Haugerud and Chainani disclose characterized in that the toy comprises keys integrated in the toy, the keys being capable of activating the icons (Chainani: Figure 2-item 29).

Referring to claim 9, Haugerud and Chainani disclose the toy comprises communication means for receiving commands that can be converted into a program that can be executed by the microprocessor (Chainani: Figure 2, item 40).

Referring to claim 10, Haugerud and Chainani disclose the toy comprises communication means for transmission of commands (Chainani: Figure 1: the personal computer 10 transmits information to the remote control device).

Referring to claim 11, Haugerud and Chainani disclose the toy comprises communication means for transferring information via a light guide (Chainani: 5:40-67).

Referring to claim 12, Haugerud and Chainani disclose the toy comprises an elongated light guide through which visible light may be transmitted in its longitudinal direction, the light guide being adapted to allow part of the light transmitted to escape through it sides (Chainani: 5:40-67).

Referring to claim 13, Haugerud and Chainani disclose toy building elements with coupling means for mutual coupling (Chainani: Figure 2).

Claims 14-16 and 18-26 correspond in scope to a toy building element set forth for use of the toy building element listed in the claims above and are encompassed by use as set forth in the rejection above.

Claims 27-28 and 30-34 correspond in scope to a toy building element set forth for use of the toy building element listed in the claims above and are encompassed by use as set forth in the rejection above.

Referring to claim 29, Haugerud and Chainani disclose the microprocessor is adapted to receive signals from electrical and/or electronic units.

***Response to Arguments***

Applicant's arguments filed February 19, 2004 have been fully considered but they are not persuasive.

Applicants argue that neither Haugerud nor Chainani disclose the claimed communication from the sensors to the microprocessor which controls the patterns of movement and the icons. However, based on the system as claimed, Haugerud in combination with Chainini disclose a processor receiving signals from sensors and the processor changing at least a portion of the patterns of movement associated with at least a portion of the icons in response to the signals (3:40-53, 8:27-31, 11:37-51). The claim language allows for multiple processors, one being the processor disclosed with the remote controlled device (Chainini 3:40-53, 8:27-31, 11:37-51) and the second processor at the controller issuing the commands by the icons (Haugerud abstract). Further, the claim language is not so limiting as to exclude the use of the interface and the toy element being the toy building element. The Applicants use the term "integrated" to differentiate their invention from the combination of Haugerud and Chainini. However, the term integrated can be defined as being to join with something else or unite. Thus, the claimed invention fails to preclude the invention of Haugerud and Chainini.

Applicants assert that the communication from the sensors to the microprocessor is very different from the cited references. However, as shown above, the claim language is not so limiting as to exclude the communications of Haugerud and Chainini. Therefore, the claimed invention fails to preclude the invention of Haugerud and Chainini.

### ***Conclusion***

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The definition of the term integrate.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-Th 8-6.




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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ajc



JESSICA HARRISON  
PRIMARY EXAMINER